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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,453	06/27/2003	Recai Sezi	MUH-12686	6595
24131	7590	02/13/2006	EXAMINER	
LERNER GREENBERG STEMER LLP			HAMPTON HIGHTOWER, PATRICIA	
P O BOX 2480			ART UNIT	
HOLLYWOOD, FL 33022-2480			PAPER NUMBER	

1711

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/609,453

Applicant(s)

SEZI ET AL.

Examiner

Patricia Hightower

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/27/03, 11/07/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: POA 11/07/03; CHANGE ADDRESS 12/20/04.  
Continuation of Attachment(s) 3). IDS; 7/30/04, 5/13/2005, 7/01/05

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**Priority**

The priority document(s) filed August 29, 2003 is acknowledged and has been made of record.

**Information Disclosure Statement**

The information disclosure statements filed June 27, 2003, November 07, 2003, July 20, 2004, May 13, 2005 and July 01, 2005.

**Double Patenting**

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-13 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-15 of prior U.S. Patent No. 6,806,344. This is a double patenting rejection.

The instant application claims a poly-o-hydroxyamide having the structural formula (I), the polybenzoxazole obtained from a poly-o-hydroxyamide having the structural formula (I), a process for preparing a poly-o-hydroxyamide having the formula (I) comprising reacting a monomer having the formula (II) with at least one of a dicarboxylic acid and an activated dicarboxylic acid derivative having the formula (III); the process of preparing a polybenzoxazole comprising heating a

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poly-o-hydroxyamide having the formula (I), an electronic component comprising a dielectric including a polybenzoxazole and a process for producing an electronic component including a polybenzoxazole comprising preparing in a solvent a solution of a poly-o-hydroxyamide having the formula (I), applying the solution to a substrate, evaporating the solvent to form a film, heating the film to cyclize the poly-o-hydroxyamide of the formula (I) to give a polybenzoxazole, structuring the film to obtain a resist structure having trenches, depositing a conductive material on the resist structure to fill the trenches the conductive material and removing excess conductive material and the process for producing an electronic component including a polybenzoxazole comprising preparing in a solvent a solution of poly-o-hydroxyamide having the structural formula (I), applying the solution to a substrate the substrate having a surface with metallic structures and trenches between the metallic structure, evaporating the solvent to fill the trenches with the poly-o-hydroxyamide having the structural formula (I), heating the substrate to cyclize the poly-o-hydroxyamide of formula (I) to yield the polybenzoxazole. The inventions as claimed by the application is viewed as claiming the same invention(s) as USP 6,806,344. The patent claims a poly-o-hydroxyamide having the structural formula (I), a polybenzoxazole obtained from the poly-o-hydroxyamide having the structural formula (I), a process of preparing a poly-o-hydroxyamide having the structural formula (I) comprising providing a monomer denoted by formula (II) reacting the monomer with at least one dicarboxylic acid and an activated dicarboxylic acid derivative having the formula (II) further comprises a base during the reacting step; a process for preparing a

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polybenzoxazole comprising heating a poly-o-hydroxyamide having the structural formula (I); an electronic component comprising a dielectric including a polybenzoxazole comprising preparing a solution of poly-o-hydroxyamide having the structural formula (I) in a solvent, applying the solution to a substrate, evaporating the solvent to obtain a film, heating the film to cyclize the poly-o-hydroxyamide having the formula (I), structuring the film to obtain a resist structure having trenches and contact holes formed therein on, depositing a conductive material on the resist structure to fill the trenches and contact holes conductive material removing the an excess of the conductive material; a process for producing an electronic component comprising preparing a solution of a polyo-hydroxyamide having the structural formula (I) in a solvent, applying the solution to a substrate having a surface with trenches and contact holes formed therein, disposing(depositing) metallic structures on the surface, the trenches and contact holes being disposed (deposited) between the metallic structures, evaporating the solvent to fill the trenches and contact holes with the poly-o-hydroxyamide having the formula (I) and heating the substrate to cyclize the poly-o-hydroxyamide having the structural formula (I) further comprising adding a porogen (base) to the solution of the poly-o-hydroxyamide having the formula (I).

In a circumstance where two sets of claims recite word-for word limitations, it is a clear instance in which one set of claim cannot be infringed without literally infringing the other set of claims. Thus, the double patenting rejection is proper.

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**Prior Art**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sezi '162, Giffard and Lowack '284 are cited to show the state of the art of poly-o-hydroxyamides and poly-o-mercaptoamides, poly-o-hydroxyamide, polybenzoxazoles and process of producing and electronic components made therefrom and methods of making.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Hightower whose telephone number is (571) 272-1073. The examiner can normally be reached on M-F from 9:30 A.M. - 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patricia H. Hightower

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Primary Examiner  
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P. Hightower:ph  
January 21, 2006